

Application No. 10/765,511

PATENT

Response Dated 12/16/2009

Reply to Office Action of 10/02/2009

Agent's Docket No. 2173-170

Remarks:

Claims 1 to 10, 12, and 13 are pending in the application.

Claims 1 to 10, 12, and 13 stand rejected.

No amendments are being submitted herein.

Double patenting objection

Claims 1 to 10, 12 and 13 stand rejected on the ground of non-statutory double patenting over U.S. Patent 7,222,340 ('340) in view of Birum and Yu. Applicant respectfully disagrees.

Applicant notes the absence from the outstanding Office Action of a statement regarding *Graham* factual inquiries for a §103 analysis required under non-statutory obviousness type double patenting in accordance with MPEP §804.

The Examiner alleges that while the claims of the '340 patent do not explicitly teach the limitation of "sending ... an identifier indicating a particular carrier company associated with the wireless mobile device to the network", the limitation is obvious in view of Birum and Yu.

Applicant agrees with the Examiner that this limitation is not taught by the claims of the '340 patent however, Applicant disagrees with the Examiner that this limitation is taught by either Birum or Yu taken singly or in combination.

The sending of configuration file described at [para. 0046] of Birum is not, as alleged by the Examiner, equivalent of "sending a software identifier". Birum contemplates sending an entire file rather than a software identifier as defined in the present claims. Furthermore, and as acknowledged by the Examiner, Birum does not teach the limitation of an "identifier indicating a particular carrier company associated with the wireless device". However, the Examiner has cited Yu as teaching this limitation, Applicant respectfully disagrees and submits that the Yu reference does not cure this deficiency in Birum for the following reasons:

a) In respect of identifiers applicant respectfully submits that Yu describes something entirely different, namely a mobile station sending only mobile station identifiers to the network.

Column 3 line 63 to column 4 line 2 of Yu reads:

"Mobile station 150a originates a call (e.g., by dialing the telephone number of an ordinary subscriber ...). The dialed number and the mobile identification number/electronic serial number (MIN/ESN) pair are sent over the control channel to the base station and forwarded to the BSC 300 which validates the mobile station 150a."

Yu particularly points out the scope of mobile identifiers at column 4 lines 38 to 46 which reads:

"The mobile station identifier (i.e., record index) can be, for example, the mobile station's directory number, the international mobile station identification, or the electronic serial number, which is a 32 bit sub-field of the registration message. While the above mobile station identifiers comprise those most commonly used, it is contemplated that other mobile station identifier's could be used within the teachings of the present invention."

Applicant respectfully submits that a person of ordinary skill in the art would understand that the claimed "identifier indicating a particular carrier company associated with the wireless mobile device" as defined in present independent claims, is not within the scope of the mobile station identifier as defined by Yu.

Based on description in the Yu reference, no other information is sent from the mobile station to the base station.

Therefore, according to the Applicant's understanding of the Yu reference when taken as a whole, Yu does not teach, suggest or contemplate "sending ... an identifier indicating a particular carrier company associated with the wireless device" as set forth in independent claims 1, 10 and 12.

b) The Applicant's understanding of the Birum and Yu references when taken as a whole is limited to mobile station identifiers.

c) In respect of the claimed limitation of "particular carrier company associated with the wireless device", as defined in the present claims, the "preferred traffic carrier" referred to by Yu describes something entirely different.

Specifically, as stated at column 2 lines 12 to 24, Yu defines the preferred traffic carrier as a traffic carrier for completing a call:

"a desired traffic carrier (DFC) database, ... Each DFC database includes a record for each service provider's test mobile station in the communication system. Each DFC database record includes at least two data fields: a mobile station identification field which is the record index, and a preferred traffic carrier field which identifies a preferred traffic carrier which represents the traffic carrier to be preferably selected for assignment to the mobile station involved in a call setup."

In particular, "preferably selected for assignment to the mobile device involved in a call setup" is further expanded upon in the Yu reference at column 5 line 45 to column 6 line 2 wherein Yu makes it clear that the selection is not determinative of assignment but rather that the selection is made for possible assignment because assignment is dependent on traffic carrier availability:

"After having determined the preferred traffic carrier for the mobile station at step 22, the BSC must determine whether that preferred traffic carrier is presently available at step 24. If it is determined that the preferred traffic carrier is available, the method will assign the call to the preferred traffic carrier at step 30. However, if it is determined that the preferred traffic carrier is not available, the method will alternatively make a standard traffic carrier assignment during the call setup stage, at step 26, or alternatively reject the call by providing a tone or announcement. In the event a standard traffic carrier assignment is made at step

26, the process then determines whether the preferred traffic channel is available after a predetermined period of time at step 28. If the preferred traffic channel becomes available after a predetermined period of time, a soft handoff procedure is initiated to handoff the call from the standard carrier to the preferred carrier at step 32. However, if the preferred traffic channel is not available after the period of time, the process begins another periodic cycle and then checks, at the end of the cycle, if the preferred traffic channel is available.

It should be further noted that in the event that a completed call is dropped or lost while being monitored during a drive test, an attempt is made to preferably re-establish the call on the preferred traffic carrier."

Therefore, applicant further respectfully submits that the preferred traffic carrier for completing a call described in the Yu reference can not teach the "particular carrier company associated with the wireless device" the limitation or as claimed.

d) In respect of the limitation or "sending ... an identifier indicating a particular carrier company associated with the wireless mobile device to the network", applicant respectfully submits that the Yu reference describes something entirely different, namely determining a preferred traffic carrier. The definition of a Desired Traffic Carrier database at column 2 lines 12 to 24 reads:

"a desired traffic carrier (DFC) database, specific to the present invention, can be located with and controlled by each base station, base station controller (BSC), or mobile switching center (MSC) in a mobile communication system. Each DFC database includes a record for each service provider's test mobile station in the communication system. Each DFC database record includes at least two data fields: a mobile station identification field which is the record index, and a preferred traffic carrier field which identifies a preferred traffic carrier which represents the traffic carrier to be preferably selected for assignment to the mobile station involved in a call setup."

The functionality by which the network becomes aware of the preferred traffic carrier is

described in the Yu reference at column 5 lines 40 to 47:

"In step 22, the BSC accesses the DFC database for the mobile station originating/receiving the call using the mobile station's identifier as an index into the database to find the record corresponding to the mobile station either receiving/originating the call, and selecting from that record the preferred traffic carrier. After having determined the preferred traffic carrier for the mobile station at step 22 ...".

Therefore, applicant respectfully submits that a person of ordinary skill in the art would understand that because the DFC database is already stored at a network element in the wireless network, the Yu reference teaches away from the claimed "sending ... an identifier indicating a particular carrier company associated with the wireless mobile device to the network".

e) In support of the combining of Birum with Yu, Examiner alleges that the description in Yu of 'A further advantage of the present invention is that the DFC database allows for effortless software upgradability and expansion of the testing system' suggests this combination.

Applicant respectfully disagrees for the following reasons:

- i) Applicant respectfully submits that "upgradability and expansion of the testing system" is not claimed, and also respectfully submits that the present application is not concerned with testing or testing systems.
- ii) Applicant respectfully submits that while Yu mentions the advantage referred to by the Examiner, Yu does not teach the advantage because no enabling disclosure exists in Yu, which addresses the upgradability and expansion of the testing system.

Therefore, applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art to combine the Birum and Yu references.

Therefore, applicant respectfully submits that a case of double patenting has not been established in respect of independent claims 1, 10 and 12 by failure to produce prior art teaching of each and every element claimed and because it would not have been obvious to one of ordinary skill in the art to combine the cited references.

Dependent claims 2 to 9 and 13 variously depend directly and/or indirectly from independent claims 1 and 12, and therefore incorporate all respective limitations of independent claims 1 and 12. Applicant respectfully submits that a case of non-statutory double patenting has not been established in respect of dependent claims 2 to 9 and 13 for the above reasons.

Obviousness rejection under 35 U.S.C. §103

a) Claims 1, 3 to 10 and 12 stand rejected under 35 U.S.C. §103(a) as unpatentable over Birum in view of Yu. Applicant respectfully disagrees.

Independent claims 1, 10 and 12 require “sending... an identifier indicating a particular carrier company associated with the wireless mobile device to the network”, and to a mobile station sending same.

Birum does not describe sending an identifier indicating a particular carrier company associated with the wireless device as stated by the Examiner on page 11(top), page 14(middle),

page 19(bottom) and 23(second paragraph) of the outstanding Office Action. Applicant

respectfully submits that the Yu reference does not cure this deficiency for reasons presented hereinabove traversing the non-statutory double patenting rejection.

Therefore, applicant respectfully submits that a case of obviousness has not been established in respect of independent claims 1, 10 and 12 by failure to produce prior art teaching of each and every element claimed and because it would not have been obvious to one of ordinary skill in the art to combine the cited references.

Dependent claims 3 to 9 variously depend directly and/or indirectly from independent claim 1, and therefore incorporate all respective limitations of independent claim 1. Applicant respectfully submits that a case of obviousness has not been established in respect of dependent claims 3 to 9 for the above reasons.

b) Claims 2 and 13 stand rejected under 35 U.S.C. §103(a) over Birum in view of Yu and Moore. Applicant respectfully disagrees.

Dependent claims 2 and 13 respectively depend directly from independent claims 1 and 12 and therefore incorporate all respective limitations of independent claims 1 and 12. The articulated rejection relies on the teachings of Birum and Yu. Moore does not cure the deficiency in Birum and Yu with respect to "sending ... an identifier indicating a particular carrier company associated with the wireless mobile device to the network".

Applicant respectfully submits that a case of obviousness in respect of dependent claims 2 and 13 has not been established for the above reasons.

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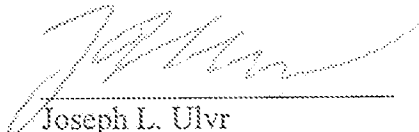
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Applicant respectfully submits that the above arguments raise questions regarding the establishment of a case of unpatentability.

Reconsideration and allowance are respectfully requested.

Respectfully submitted,



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